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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,541	12/19/2001	Richard Joseph Caballero	M-12420-2C US	2447
60975	7590	10/04/2006	EXAMINER	
CSA LLP 4807 SPICEWOOD SPRINGS RD. BLDG. 4, SUITE 201 AUSTIN, TX 78759			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,541

Applicant(s)

Caballero et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 11, 2006 (RCE w/Amdt).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 45-75 is/are pending in the application.
- 4a) Of the above claim(s) 45-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 18, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 11, 2006 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on September 11, 2006 in reply to the previous Office action on the merits, mailed May 3, 2006.

3. The amendment of claims 1-15 by applicant in the reply filed September 11, 2006 is hereby acknowledged.

Election/Restriction

4. This application contains claims 45-75 drawn to an invention nonelected with traverse in the reply filed February 13, 2006. A complete reply to the final rejection must include cancellation of the nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Claim Rejections - 35 USC § 101

5. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. To be considered statutory, claimed subject matter requires four things¹:

(1) the claimed subject matter *must* lie within the ambit of the *four classes* of statutory subject matter enumerated in 35 U.S.C. 101, those being any new and useful *process, machine, manufacture, or composition of matter*;

(2) the claimed subject matter *must not* fall within any of the *three categories* of statutory subject matter *exceptions* enumerated by the courts, those being, *in the absence of any practical application: abstract ideas, laws of nature, and natural phenomena*;

(3) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must not preempt* the underlying abstract ideas, laws of nature, or natural phenomena by foreclosing others from *substantially all other practical applications* of the *same* abstract ideas, laws of nature, or natural phenomena; *and*,

(4) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must* be evidenced in at least one of two possible ways:

(a) by transforming an article or physical object to a different state or thing; or,

(b) by otherwise producing any useful, concrete, and tangible result.

¹ *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, published by order of the Commissioner for Patents, available in pdf format online on the Internet at: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf.

7. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Method claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Method claims 1-15 fail to satisfy the fourth, and thus the second, requirements for statutory subject matter eligibility because they are considered to be drawn merely to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Moreover, method claims 1-15 fail to satisfy the third requirement for statutory subject matter eligibility because they are considered to *preempt* the underlying abstract idea, since they would foreclose others from *substantially all practical applications* of the *same* abstract idea. It has been held that such claims are considered to be unpatentable for comprising non-statutory subject matter. *In re Schrader*, 22 F.3d 290, 295; 30 USPQ2d 1455, 1459 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiecha et al. (US 5,870,717).

Wiecha et al. disclose a computer-implemented method comprising: generating a list of accounts; selecting a selected account by detecting selection of one of the accounts, wherein the selecting a selected account is performed using a computer; generating a list of orders associated with the selected account, wherein the list of orders comprises orders that have been submitted to an external provisioning system for provisioning, and the computer and the external provisioning system are communicatively coupled to one another; selecting a selected order by detecting selection of one of the orders that has been submitted for provisioning by the external

provisioning system, wherein the selecting a selected order is performed using the computer; detecting a request to make a change to the selected order, wherein the request comprises a change to the selected order; incorporating the change in the selected order; submitting a re-submitted order by submitting the selected order for provisioning by the external provisioning system; and, synchronizing the re-submitted order in the external provisioning system to override the one of the orders that had been submitted for provisioning.

Regarding claim 2, the method of Wiecha et al. further comprises: generating a list of items comprising the selected order; determining whether each item in the list of items has been delivered; selecting a selected item by detecting selection of one of the items; and, allowing a user to reconfigure the selected item if the selected item has not been delivered.

Regarding claim 3, the method of Wiecha et al. further comprises: changing the status of the selected item to indicate that the selected item has been updated.

Regarding claim 4, the method of Wiecha et al. further comprises: changing the status of the selected order to indicate that the selected order has been updated.

Regarding claim 5, the method of Wiecha et al. further comprises: generating a list of quotes associated with the selected account.

Regarding claim 6, the method of Wiecha et al. further comprises: generating a list of quotes associated with the selected account; selecting a quote by detecting selection of one of the quotes; detecting a request to make a change to the selected quote; and, incorporating the change in the selected quote.

Regarding claim 7, the method of Wiecha et al. further comprises: generating a list of assets associated with the selected account; selecting a selected asset by detecting selection of one of the assets; detecting a request to make a change to the selected asset; and, incorporating the change to the asset in a quote.

Regarding claim 8, the method of Wiecha et al. further comprises: submitting the selected quote to an order.

Regarding claim 9, the method of Wiecha et al. further comprises: generating a list of items comprising the selected asset; selecting a selected item by detecting selection of one of the items; and, allowing a user to reconfigure the selected item.

Regarding claim 10, the method of Wiecha et al. further comprises: ungrouping the selected item with a quantity of more than one to a corresponding multiple of items; and, allowing the user to individually reconfigure each item of the multiple of items.

Regarding claim 11, the method of Wiecha et al. further comprises: , further comprising: generating a list of quotes associated with the selected account; selecting a selected quote by detecting selection of one of the quotes; and, detecting selection of an option to update potential revenue based on the price of items in the selected quote.

Regarding claim 12, the method of Wiecha et al. further comprises: detecting selection of an option to create a quote for a new asset, wherein the quote is associated with the selected account; generating a list assets comprising products and services available; selecting a selected asset by detecting selection of an asset; and, invoking a product configurator to allow the user to configure the selected asset.

Regarding claim 13, in the method of Wiecha et al. the change comprises disconnecting the asset.

Regarding claim 14, in the method of Wiecha et al. the change comprises transferring the selected asset, the method further comprising: detecting selection of an option to transfer the selected asset; copying information about the configuration of the selected asset to a quote; setting the status of items in the quote to indicate that the items are to be included in a service profile at a new address; and, copying information about the selected asset.

Regarding claim 15, the method of Wiecha et al. further comprises: copying the information about the configuration of the selected asset to a second quote; and, setting the status of items in the quote to indicate that the items are to be disconnected in a service profile at an old address.

Response to Arguments

10. Applicant's arguments filed September 11, 2006 have been fully considered but they are not deemed persuasive.

11. Regarding the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "submission of an order for provisioning") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Regarding the argument that Wiecha fails to disclose the claimed “synchronizing,” Wiecha indeed includes “synchronizing” a changed order to override a previous version of the order (i.e., to replace an erroneous order with a corrected one). See, for example, the “Change orders & Cancellations” functionality in Figure 7 on the front page (to the right of the EDI Gateway 130).

To the extent that applicant is arguing that the particular names/words/terms used by applicant differ from the particular names/words/terms in the reference, it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Additionally, note that, during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

13. Regarding the argument that Wiecha fails to disclose making changes to the orders that have been submitted, Wiecha indeed discloses making changes 860 to the orders that have been submitted. See, for example, column 4, lines 49-52; column 10, lines 44-53; and, column 15, line 24 et seq.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.
15. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

September 30, 2006



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

9/30/06